

REMARKS/ARGUMENTS

Applicants have studied the Office Action dated April 14, 2009, and have made the above amendments and the following remarks and submit that all pending claims 1 to 20 of the present application are in condition for allowance. Claims 1, 19 and 20 have been amended. Reconsideration and allowance of the pending claims in view of the above amendments and the following remarks is respectfully requested.

In the Office Action, the Examiner rejected claims 1 through 20 under 35 U.S.C. § 103(a) as being obvious and therefore, unpatentable over U.S. Patent No. 6,787,301 to *Ganser et al.* (hereinafter “*Ganser*”) in view of U.S. Patent No. 5,592,289 to *Norris*. With regards to independent claims 1, 19 and 20, as set forth in detail below, Applicants respectfully disagree that the Examiner has established a *prima facie* case of obviousness in several respects and, therefore, the rejection of claims 1, 19 and 20 should be withdrawn.

To establish a *prima facie* case of obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q 580 (CCPA 1974); MPEP §2143.03. The U.S. Supreme Court has held that the Federal Circuit’s teaching, suggestion, or motivation test is not inconsistent with the analysis set forth in *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1 (1966), and can be used in the “expansive and flexible approach” of determining obviousness *vel non*. *KSR Int’l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1739 (2007). See also *DyStar Textilfarben GmbH & Co. Deutschland KG. v. C.H. Patrick Co.*, 464 F.3d 1356, 1367 (Fed. Cir. 2006) (flexible approach); *Alza Corp. v. Mylan Labs., Inc.*, 464 F.3d 1286, 1291 (Fed. Cir. 2006) (flexibility in obviousness jurisprudence). “Under Section 103 teachings of references can be combined **only** if there is some suggestion or incentive to do so.” *ACS Hospital Systems, Inc. v. Montefiore Hospital et al.*, 221 USPQ 929, 933, 732 F.2d 1572 (Fed. Cir. 1984) (emphasis original). “Although a reference need not expressly teach that the disclosure contained therein should be combined with another, the showing of combinability, in whatever form, must nevertheless be ‘**clear and particular**.’” *Winner Int’l Royalty Corp. v. Wang*, 53 USPQ2d 1580, 1587, 202

F.3d 1340 (Fed. Cir. 2000) (emphasis added; citations omitted); Brown & Williamson Tobacco Corp. v. Philip Morris, Inc., 56 USPQ2d 1456, 1459 (Fed. Cir. Oct. 17, 2000). Applied to the circumstances here, there is no teaching, no suggestion, and no motivation to arrive at each and every element of claims 1, 19, and 20.

Furthermore, in *Graham v. John Deere Co.*, the U.S. Supreme Court held that in applying the “nonobviousness condition on patentability … the Patent and Trademark Office should make ‘several basic factual inquiries.’ The inquiries are: (1) ‘the scope and content of the prior art,’ (2) ‘differences between the prior art and the claims at issue,’ and (3) ‘the level of ordinary skill in the pertinent art.’” *Chisum on Patents*, §5.03. In *KSR Int'l Co. v. Teleflex Inc.*, this factual inquiry was recently reaffirmed by the Court as being the “framework for objective analysis for determining obviousness.” MPEP §2141. “Once the *Graham* factual inquiries are resolved, Office personnel must determine whether the claimed invention would have been obvious to one of ordinary skill in the art.” *Id.* In determining whether the claimed invention would have been obvious to one of ordinary skill in the art, there must have been “a reasonable expectation of success” at the time the claimed invention was made. *In re Merck & Co., Inc.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986), cited in, MPEP § 2143.02. “Obviousness does not require absolute predictability, however, at least some degree of predictability is required. Evidence showing there was no reasonable expectation of success may support a conclusion of nonobviousness.” *Id.*, citing *In re Rinehart*, 531 F.2d 1048 (CCPA 1976). Thus, if the Examiner cannot show that there would have been a reasonable expectation of success to combine the elements of the prior art at the time of Applicants’ invention, the Examiner has failed to establish a *prima facie* case of obviousness.

Before discussing the prior art in detail, it is believed that a brief review of the invention as claimed, would be helpful. The present invention provides a laser dissection system with a holder for holding a receptacle device with a plurality of receptacle containers. See FIGS. 2A & 2B and page 13, lines 24-26, of the present application as originally filed. The holder has a unique coding feature 22 that identifies the type of the receptacle device being held by the holder. *Id.* at page 12, lines 11-20. Furthermore,

the laser microdissection system has identification means for identifying the receptacle device by recognizing the coding feature of the holder. In addition, the laser microdissection system has control means that are designed so that, depending on the receptacle device respectively identified, the control means displays information on the receptacle device and provides selection functions that are specific to the identified receptacle device to allow a user to allocate individual biological objects to be excised from the biological material to individual receptacle containers of the receptacle device. *Id.* at page 12, line 28, to page 13, line 22, and pages 15 and 16. Each of these elements is clearly present in independent claims 1, 19, and 20.

Although *Ganser* discloses a laser micro-dissection system, it does not disclose that the system includes a holder. The holder of the present invention is clearly described in the specification and claims as being designed for use so that it can hold a receptacle device having a plurality of receptacle containers. *Id.* at page 17, lines 9-19, page 15, lines 8-14; page 12, lines 8-26; claims 1, 19, and 20, and FIG. 2A (elements 20, 30, and 31). *Ganser* merely discloses a single receptacle container in the form of a so-called "collection vessel"¹ without ever disclosing a holder for a receptacle container or a corresponding receptacle device. See *Ganser* at col. 5, lines 31-33, and col. 6, lines 13-14 and 29-31. Accordingly, *Ganser* fails to disclose a receptacle device having a plurality of receptacle containers which can receive biological objects automatically by a control of a laser microdissection system irradiating objects with a laser beam of the laser microdissection system, as is disclosed in the present invention and recited in the independent claims.

On page 2 of the Office Action, the Examiner cites to col. 2, lines 57-67, and col. 3, lines 1-11, of *Ganser* for showing support of a "holder." However, the "holder" disclosed in these sections identified by the Examiner is "a specimen holder," as opposed to "at least one holder that ...can hold a receptacle device having a plurality of receptacle containers, each receptacle container provided for receiving the biological object

¹ *Ganser* references element 19 as a "collection vessel," but none of the figures in *Ganser* show an element 19.

excised from the biological material," as recited in claims 1, 19, and 20 of the present application. The holder in *Ganser* is the displaceable object carrier or X-Y stage. See Examiner's cited passages. It is clear from the language of the independent claims of the instant application that the displaceable X-Y stage of *Ganser* does not fulfill the features of the "holder" presently claimed. In short, *Ganser* fails to disclose any holder or any receptacle device with a plurality of receptacle containers. Finally, it is noted that the present rejection does not specifically address Applicants' arguments regarding the lack of a holder in *Ganser*, as presented in the January 5, 2009 response to the first Office action.

Furthermore, *Ganser* does not describe the system as having identification means and control means or a controller that provides selection functions specific to the receptacle device for the allocation of individual biological objects to be excised from the biological material to individual receptacle containers of the identified receptacle device, as are required in claims 1, 19, and 20 of the present application. The laser microdissection system of the present invention, as defined in claims 1, 19, and 20, includes a holder for holding a receptacle device that has a coding that identifies the specific type of the receptacle device. The laser microdissection system has identification means for identifying the receptacle device by evaluating the coding of the holder. The laser microdissection system has control means that are designed so that, depending on the receptacle device respectively identified by the identification means, the control means displays information to a user on the receptacle device and provides selection functions that are specific to the identified receptacle device to allow the user to allocate individual biological objects to be excised from the biological material to individual receptacle containers of the receptacle device. See, e.g., page 15, lines 18-19 and 30-31, page 18, lines 10-15, and page 19, lines 5-19, of the application as originally filed.

Claims 1, 19, and 20 have been amended to further clarify that the selection functions are provided to the user for a user-defined allocation of biological objects to receptacle containers and are dependent upon the specific receptacle device that has been identified. This amendment has not been made to distinguish the present invention

from *Ganser* (either alone or in view of *Norris*) and has been made only as a clarification in response to the Examiner's rejection of the claims under 35 U.S.C. § 103(a) so that the invention can be better understood. No new matter has been introduced nor have any equivalents been surrendered. Various implementations of selection functions specific to the respectively identified receptacle device are described in detail on page 15, line 18, through page 22, line 2, of the present application.

In contrast, *Ganser* discloses that "a desired reference cut line for the cutting operation that is to be performed is marked by a user in the camera image, using a corresponding software program, by means of a computer mouse." See *Ganser* at col. 5, lines 43-50. While the marking of the desired reference cut line could be considered to represent a selection of a biological object to be excised, the selection of the object is not performed in a way that is specific to the receptacle device and instead, is free to the user to control or is a function of the laser parameters. *Id.* Also, the marking of the cut line, as taught by *Ganser*, does not allow a user to allocate individual biological objects to be excised to individual receptacle containers. Rather, the dissected specimen region of interest falls down into a collection vessel arranged below it. *Id.*, at col. 6, lines 13-14.

The Examiner goes on to combine *Norris* with *Ganser* in an effort to compensate for the fact that *Ganser* does not describe an identification means in addition to a control means or controller as is required in claims 1, 19, and 20 of the present application. However, *Norris* does not relate to a laser microdissection system as described and claimed in the present application. While the Examiner has asserted that *Norris* teaches controlling the position of a receptacle device to allow for preparation of samples, there are no specific disclosures relating to sample preparation in *Norris*. Rather, as explicitly stated, for example in col. 1, lines 8-10, col. 2, lines 62-67, and claims 1 and 11 of *Norris*, *Norris* relates to the analysis of analyte samples rather than sample preparation, which are two very distinct and separate functions. Contrary to the Examiner's suggestion, it would not have been obvious to use the identification mechanism for a **sample analysis system**, as taught by *Norris*, in the laser microdissection system of *Ganser*, which relates to **sample preparation**. The

Examiner has not provided any support for the position that there would have been a reasonable expectation of success to combine the elements of the *Norris* and *Ganser* at the time of Applicants' invention. Accordingly, the Examiner has failed to establish a *prima facie* case of obviousness. The rationales underlying the Examiner's rejections suggest that sample **analysis** devices be bodily incorporated into a sample **preparation** system, but, such an incorporation is unconventional and non-obvious.

Moreover, the positioning mechanism described in *Norris* does not provide for user interaction so that it can be used for a **user-defined allocation** of biological objects to receptacle containers. In *Norris*, information about the configuration of a particular receptacle is provided to a computer that controls the operation of a measuring instrument. See *Norris* at col. 3, lines 5-14, and col. 7, lines 46-52. The computer may control the measurement pattern for the measurement instrument. However, *Norris* does not disclose that the information about the configuration of a receptacle container is **displayed to a user**. Further, *Norris* is devoid of any teaching or suggestion relating to the provision of selection functions **specific** to the receptacle container. Furthermore, *Norris* does not even disclose or suggest that the computer, to which information about the configuration of a receptacle container is provided, is configured to **interact with a user**. Rather, *Norris* describes an automatic, computer-controlled system for accurately aligning an analyte receptacle with respect to a measuring device performing the assays. See *Norris*, col. 7, line 12 - col. 9, line 34. None of the rationales provided by the Examiner for combining the teachings of *Gasner* and *Norris* implies that information on the receptacle device is displayed to the user. Similarly, none of the rationales implies that selection functions specific to the receptacle device are provided so as to allow a user to allocate individual biological objects to be excised from the biological material to individual receptacle containers.

For the foregoing reasons, independent claims 1, 19, and 20, as amended, distinguish over *Ganser* taken alone and/or in view of *Norris*. Claims 2-18 depend from independent claim 1. Since dependent claims contain all the limitations of the independent claims, claims 1-18 distinguish over *Ganser* taken alone and/or in view of

Norris as well, and the Examiner's rejection should be withdrawn.

CONCLUSION

In this Response, Applicants have amended certain claims. In light of the Office Action, Applicants believe these amendments serve a useful clarification purpose, and are desirable for clarification purposes, independent of patentability. Accordingly, Applicants respectfully submit that the claim amendments do not limit the range of any permissible equivalents.

Applicants acknowledge the continuing duty of candor and good faith to disclosure of information known to be material to the examination of this application. In accordance with 37 CFR §1.56, all such information is dutifully made of record. The foreseeable equivalents of any territory surrendered by amendment are limited to the territory taught by the information of record. No other territory afforded by the doctrine of equivalents is knowingly surrendered and everything else is unforeseeable at the time of this amendment by the Applicants and their attorneys.

Applicants respectfully submit that all of the grounds for rejection stated in the Examiner's Office Action have been overcome, and that all claims in the application are allowable. No new matter has been added. It is believed that the application is now in condition for allowance, which allowance is respectfully requested.

It is believed that no fee is due with this Amendment. However, if any fees are due with respect to Sections 1.16 or 1.17, please charge to the deposit account of the undersigned firm, Acct. No. 503,836.

PLEASE CALL the undersigned if that would expedite the prosecution of this application.

Respectfully submitted,

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